



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/870,716	05/30/2001	Hiroshi Urabe	71369-55968	8909

7590 03/30/2006

Dike, Bronstein, Roberts & Cushman
Intellectual Property Practice Group
Edwards & Angell
P.O. Box 9169
Boston, MA 02209

EXAMINER

NUTTER, NATHAN M

ART UNIT	PAPER NUMBER
----------	--------------

1711

DATE MAILED: 03/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES DEPARTMENT OF COMMERCE

U.S. Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
---------------------------------	-------------	---	---------------------

EXAMINER

ART UNIT	PAPER
----------	-------

0306

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

Nathan M. Nutter
Primary Examiner
Art Unit: 1711

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/870,716

Applicant(s)

URABE ET AL.

Examiner

Nathan M. Nutter

Art Unit

1711

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 March 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: _____

Claim(s) withdrawn from consideration: _____

AFFIDAVIT OR OTHER EVIDENCE


8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☒ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s): _____

13. ☐ Other: _____


Nathan M. Nutter
Primary Examiner
Art Unit: 1711

Continuation of 11. does NOT place the application in condition for allowance because: Applicants argue the merits of the rejection based upon 35 USC 102 while the rejection was made under 35 USC 103. Since a reference is taken for the entirety of its teachings, the reference to Nakacho et al shows the suitable combination of two or more thermoplastic resins that may include a modified polyphenylene ether and polyamides and may further comprise a flame retardant, including phosphazene compounds, as claimed. Polyamides and the modified polyphenylene ethers are taught as preferred from a list of only five resins, and, further, that the resins may be used in combination. Nothing in the claims is drawn to an "anti-bleedout resin" or a "phosphazene compatibility resin," yet since the constituents may be essentially identical, these concepts would be embraced. Applicants address the issue of content with a general statement that the reference to Nakacho et al does not teach or suggest the specific combinations, nor the claimed amounts. The rejection was made under 35 USC 103, the suggestion of inclusion has been shown, as well as the amounts for inclusion. Since nothing is recited in the claims with regard to the "poor compatibility" the manipulation of the constituents would have been within the skill of an artisan. With regard to the secondary references, they are employed to show the conventionality of using magnetic powder in polyamide resins. Nothing unexpected has been shown on the record with regard to the constituents or their respective amounts. The constituents are all conventional used in a conventional manner. As to these rejections, applicants attempt to establish reasoning based upon 35 USC 102, as opposed to 35 USC 103, but have not clearly shown why such standard is applicable. With regard to the Declaration of Suzuki, there is no comparison made with the teachings of the references as employed in the rejection of the claims. The Declaration is an attempt to show characteristics of the invention without making any side-to-side comparison with that already known in the art. Further, the comparison is made only in reference to what is claimed with what is claimed less the polyphenylene ether, which is not relevant to the rejection made. One of ordinary skill in the art would have a great expectation of success using the resins as taught by Nakacho et al.

As such, the status of the claims is;

Claims allowed: None,

Claims objected to; None,

Claims rejected: 1-16,

Claims withdrawn from consideration: None.